

IFW



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Johnson et al.

Serial No. 10/619,054

Filed: 14 July 2003

For: ADJUSTABLE STORAGE SEAT FOR
RECREATION AND UTILITY
VEHICLES

To: Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

) Art Unit: 3636

) Our Ref. 49592.71.1

) (previously 10739.14.192)

) Examiner: Anthony Derrell Barfield

I hereby certify that this correspondence is being:
☒ deposited with the United States Postal Service as first-
class mail in an envelope addressed to:
COMMISSIONER FOR PATENTS, P.O. Box 1450,
Alexandria, Virginia, 22313-1450
☐ facsimile transmitted to the Patent and Trademark
Office
☐ hand delivered to the Patent and Trademark Office

on this 22nd day of October, 2004

By

Theresa Russek

RESPONSE

The present communication responds to the Office Action mailed 22 September 2004 in the above-identified application.

In the present Office Action, the Examiner argues that the application contains patentably distinct inventions and requires restriction between these inventions. The Office Action identifies the following three inventions as being patentably distinct: (I) claims 1-10 and 17-19; (II) claims 11-16; and (III) claim 20.

The Examiner states that "inventions I and II are related as subcombinations disclosed as usable together in a single combination". However, the Examiner further states that these "subcombinations are distinct from each other if they are shown to be separately usable", and Examiner makes a case for separate utility for Invention II.

The Examiner also states that "inventions I and III are related as combination and subcombination". The Examiner further states that "[I]nventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations". The Examiner suggests that "the combination as claimed here does not require the particulars of the subcombination as claimed because the subcombination requires a trunk enclosure for patentability". Further, the Examiner makes a case for separate utility for the subcombination.

Applicants, through their attorney, hereby elect claims 11-16, which the Examiner has identified as "invention II", with traverse.

Applicants traverse this restriction requirement on the grounds that no serious burden on the Examiner exists. If the search and examination of an entire application can be made without serious burden, then it must be examined on the merits even though it includes claims directed to distinct or independent inventions. M.P.E.P. §803. The subject matter that has been identified by the Examiner as representing three inventions is believed to be so related that a thorough search should encompass the subject matter of all claims of the present application. Thus, to avoid duplicative examination by the Patent Office and to prevent unnecessary expense and delay to the Applicants, it is respectfully requested that examination be performed on the merits of all claims, rather than just those of invention II.

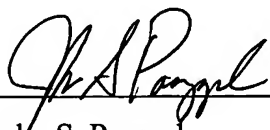
Furthermore, Applicants submit that if a determination of an allowable generic claim is issued, for instance the determination of allowability of the claim 11 in the present application, then claims that are written in dependant form or otherwise include all the limitations of the allowed generic claim should be considered. M.P.E.P. § 809.02(c).

If the Examiner feels that prosecution of the present invention can be advanced by a telephone interview, then the undersigned would welcome a call at the phone number below.

Thank you.

Respectfully submitted,

Dated: 10/22/04



John S. Parzych
Reg. No. 52,097
FREDRIKSON & BYRON, P.A.
4000 Pillsbury Center
200 South Sixth Street
Minneapolis, MN 55402-1425
(612) 492-7279
Customer No. 022859

Please grant any extension of time necessary for entry and charge any fee due to Deposit Account No. 06-1910.